

Response to Restriction Requirement (with Traverse)
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Dated: June 15, 2009
Electronic Signature for Kristin L. Murphy: /Kristin L. Murphy/

Docket No.: 66967-0037
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Rolf Cremerius

Application No.: 10/562,423

Confirmation No.: 5532

Filed: April 11, 2006

Art Unit: 3726

For: PROCESS OF MACHINING INNER AND
OUTER JOINT PARTS PARALLEL PAIRS OF
TRACKS

Examiner: D. Aujla

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

In response to the restriction requirement set forth in the Office Action mailed June 4, 2009 (Paper No. 20090603), applicant hereby provisionally elects Group I, Species A (claims 1, 21-24 and 33-37) for continued examination, with traverse.

The Examiner has required restriction between the following groups:

Group I, claims 1 and 21-24, drawn to a process of machining an outer joint part or inner joint part of a ball joint using disc tools;

Group II, claims 25-32, drawn to a process of machining an outer joint part or inner joint part of a ball joint using finger tools;

Group III, claims 35-37, drawn to device of machining an outer joint part or inner joint part of ball joint using disc tools; and

Group IV, claims 38-47, drawn to device of machining an outer joint part or inner joint part of ball joint using finger tools.

Based on review of the claims, Applicants elect Group I, with traverse. Claims 1 and 21-24 and are therefore selected explicitly for examination.

As now recognized by the Examiner, this application is a National Phase of a PCT application filed under 35 U.S.C. § 371, and is not an application filed under 35 USC § 111(a). Unity of invention is applicable in international applications and in national stage (filed under 35 U.S.C. §371) applications under PCT Rule 13 and 37 CFR § 1.475. Thus, restriction requirements are governed under the Unity of Invention standards, and the Examiner must clearly specify why the claims directed to different groups of inventions lack a common special technical feature. Indeed, under the applicable rules Unity of Invention exists when claims are directed to a common special technical feature.

MPEP §1893.03(d) explains that a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression “special technical feature” is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art.

In the election/restriction requirement, the Examiner states that the inventions listed as Groups I, II, III and IV do not relate to a single general inventive concept because . . . “the features common to all the claims . . . do not constitute ‘special technical features’ since they do not make a ‘contribution’ over the prior art in light of at least Ouchi et al. (U.S. Patent No. 6,299,542).” Applicants respectfully disagree with the Examiner’s characterization. Moreover, Applicants note the pending claims of Groups I and III do have a technical relationship that is not shown in Ouchi et al. More specifically, the claims in Group I and III both include the technical feature of the use of disc tools for machining joint parts. Group I requires a process of machining an outer joint part or

an inner joint part using disc tools. And Group III is directed to a device for machining an outer joint part or an inner joint part using “at least two disc tools.”

Thus, in view of the significant overlap of technical features between the claims of Groups I and III, is respectfully submitted that the Examiner will be required to search art not only related to Group I, but also Group III as part of the analysis. Therefore, Applicants respectfully requests that all of the pending claims of Groups I and III (claim 1, 21-24 and 33-37) be examined at this time.

In addition, the Examiner has indicated that Applicant is required to elect a single species to which the claims shall be restricted if no generic claim is allowable:

Species A; Drawn to Figs. 1a-3; and

Species B: Drawn to Figs 4a-9.

The claims are deemed to correspond to the species listed above in the following manner:

Species A; claims 1, 21-24 and 33-37; and

Species B: claims 25-47.

Based on review of the claims, Applicants elect Species A, with traverse. Claims 1, 21-24 and 33-37 read on the elected species and are selected explicitly for examination.

As stated above, the claims that read on Species A are directed to Groups I and III respectively. Thus, examination of Species A claims (1, 21-24, and 33-37) should be examined in this application.

Applicants' election is made without prejudice and with traverse. As noted by the Examiner, upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to not more than a reasonable number of species in addition to the elected species, provided

that all claims to each additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.146.

In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, consideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 66967-0037 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Dated: June 15, 2009

Respectfully submitted,

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